

REMARKS/ARGUMENTS

In view of the amendments to the claims above and the remarks and arguments below, Applicant believes the pending application is in condition for allowance.

I. Status of the Claims

Claim 1 is amended as follows.

A typographical error is corrected in the seventh line of the text defining R^1 , namely, “a C_{1-6} alkylsulfinyl group.” No new matter is introduced by the amendment.

The variable R^1 , which recited “a five or six membered heterocyclic group having at least one hetero atom selected from an oxygen atom, a nitrogen atom, and a sulfur atom, which may be substituted by G^4 ,” is limited to:

a dioxolanyl group which may be substituted by G^4 , a tetrahydrofuranyl group which may be substituted by G^4 , a dihydrofuranyl group, an oxadiazoyl group which may be substituted by G^4 , an oxazolizinyll group which may be substituted by G^4 , an oxadiazolyl group which may be substituted by G^4 , an oxazolyl group which may be substituted by G^4 .

The limitation is made without prejudice or disclaimer of the subject matter eliminated thereby. Support for the amendment can be found in the Specification, for example, in the exemplified, numbered compounds as follows: “dioxolanyl” (2-169, 5-215, and 5-218); “tetrahydrofuranyl” (5-237); “dihydrofuranyl” (5-235, 5-236, and 5-241); “oxadiazoyl” (2-200); “oxazolizinyll” (2-199, 2-201, 2-210, 2-220, 5-259, 5-260, 5-262, and 5-263); “oxadiazolyl” (5-256); and “oxazolyl” (2-205, 2-209, and 5-261). No new matter is introduced by the amendment.

The choice of “-OP(O)(OR⁸)SR⁹” is further deleted from R^1 , without prejudice or disclaimer of the subject matter eliminated thereby. In accordance with this amendment, the recitation of “R⁹” is also eliminated, that is, “wherein R⁸ and R⁹ each independently represents” No new matter is introduced by the amendments.

The variable A, which recited “a five or six membered heterocyclic group having at least one hetero atom selected from an oxygen atom and a nitrogen atom, which may be substituted by G⁴,” is limited to “a tetrahydrofuranyl group which may be substituted by G⁴.” The limitation is made without prejudice or disclaimer of the subject matter eliminated thereby. Support for the amendment can be found in the Specification, for example, in Compound No. 2-179. No new matter is introduced by the amendment.

The variable R¹⁰, which recited “a five or six membered heterocyclic group having at least one hetero atom selected from an oxygen atom, a nitrogen atom, and a sulfur atom, which may be substituted by G⁴,” is limited to “a tetrahydrofuranyl group which may be substituted by G⁴.” The limitation is made without prejudice or disclaimer of the subject matter eliminated thereby. Support for the amendment can be found in the Specification, for example, in Compound No. 2-225. No new matter is introduced by the amendment.

The variable R², which recited “a five or six membered heterocyclic group having at least one hetero atom selected from an oxygen atom, a nitrogen atom, and a sulfur atom, which may be substituted by G⁴,” is limited to “a pyrazolyl group.” The limitation is made without prejudice or disclaimer of the subject matter eliminated thereby. Support for the amendment can be found in the Specification, for example, in Compound No. 2-168. No new matter is introduced by the amendment.

The variables R³, R⁴, R⁵, and R⁶, for which it was recited that “both R³ and R⁴, or both R⁵ and R⁶, may be bound together to form a saturated ring,” are limited to the recitation that “both R³ and R⁴, or both R⁵ and R⁶, are bound together to form an azabicyclooctane core or an azabicyclononane core.” The limitation is made without prejudice or disclaimer of the subject matter eliminated thereby. Support for the amendment can be found in the Specification as originally filed, for example, on page 6, lines 21-26. No new matter is introduced by the amendment.

For the variable G¹, the choice of “a five or six membered heterocyclic group having at least one hetero atom selected from an oxygen atom, a nitrogen atom, and a sulfur atom which may be

substituted by G⁴ is eliminated without prejudice or disclaimer of the subject matter contained therein. No new matter is introduced by the amendment.

The variable n, which was recited to represent “0 or 1,” is limited to be “1.” The limitation is made without prejudice or disclaimer of the subject matter eliminated thereby. No new matter is introduced by the amendment.

New claims 14-25 are added. Support for these claims can be found in the Specification as originally filed, for example, on page 11, line 7 through page 13, line 6, on page 15, lines 3-26, and on page 167, lines 5-8. No new matter is introduced by the new claims.

Claims 4-6 and 8-13 are canceled without prejudice or disclaimer of the subject matter contained therein.

Claims 1-3, 7, and 14-25 are currently pending and at issue.

II. Amendments to the Specification

The Specification is amended to comply with the preferred layout and arrangement of a utility application, to provide the priority information for this application, and to correct typographical errors and informalities resulting from the translation of the PCT application. In particular, the following typographical errors are corrected.

Preparation Example 8 at page 24, line 14: The reference to the solution of piperidine produced in Preparation Example 7 is corrected to read “1-4” as the solution is identified in Preparation Example 7 on page 23, lines 16-17.

Preparation Example 11, Step 2 at page 30, line 2: Reference number (18) is added to the crude chemical compound in the acetonitrile suspension, as the compound is previously identified in Step 1 and in the schematic at page 30, line 1.

Example 22 at page 45, lines 9-10: The reference numbers of the target compounds of Step 1 are corrected to be (37) and (38) as indicated in the schematic at page 45, lines 11-12 and in the description of Step 1 at page 46, line 17.

Preparation Example 23, Step 4 at page 50, lines 12-13: The reference number of the target compound is corrected to be (43) as indicated in the schematic at page 50, line 13 and in the description of Step 4 at page 50, line 20.

Preparation Example 24, Step 1 at page 52, line 1: The schematic is corrected so that the reagent BnBr is corrected to read "BnOH" (benzyl alcohol), which is the reagent described in the discussion at page 52, line 7. One would recognize that reaction with benzyl alcohol, rather than benzyl bromide, would produce the desired intermediate.

Preparation Example 26, Step 2 at page 58, line 13: The reference number of the chemical compound reacted to yield the target compound is corrected to be (52) as indicated in the schematic at page 58, line 11.

Preparation Example 29, Step 1 at page 65, line 9: The reference number of the crude chemical compound produced from compound (58) is corrected to be (59) as indicated in the schematic at page 64, line 16 and in the discussion at page 65, lines 10-12, describing the subsequent reaction of the crude chemical compound.

No new matter is introduced by the amendments.

The Abstract is also amended to provide a technical disclosure that corresponds to the subject matter of the claims elected for continued prosecution. No new matter is introduced by the amendments.

III. Expansion of Definition of Group II to Include Subject Matter of Group III

Applicant appreciatively thanks Examiner David K. O'Dell for expanding the definition of Group II, following Applicant's election of Group II out of Groups I through V for prosecution, to include the subject matter previously encompassed by Group III, so that prosecution can be expedited and the costs of filing divisional applications can be reduced.¹

In line with Applicant's election and the expansion of definition of Group II above, Applicant has amended the claims so that they are no longer drawn to a non-elected invention.

IV. Telephone Interview

Applicant also appreciatively thanks the Examiner for the courtesy extended to Applicant's representative, Louis DelJuidice, in a telephone interview held on April 21, 2008. The Examiner kindly suggested that Applicant file an English translation of the International Search Report issued in the parent PCT application to have the relevant Japanese-language references considered by the Examiner.

V. Consideration of Method Claims

Applicant further appreciatively thanks Examiner O'Dell for the acknowledgment that method claims may be considered in this examination if they are dependent from allowable product claims.²

VI. Information Disclosure Statement

The Examiner states that the Japanese-language references listed in the Information Disclosure Statements ("IDS's") filed on September 27, 2006, and on November 30, 2006, have not been considered because they do not include concise explanations of relevance as required by 37 C.F.R. § 1.98(a)(3)(i).

¹ Office Action of March 24, 2008, page 2, lines 8-10.

² Office Action of January 4, 2008, page 5, lines 6-7.

In the telephone interview conducted on April 21, 2008, the Examiner suggested that filing an English translation of the International Search Report (“ISR”) issued in the parent PCT application would meet the “concise explanation of relevance” requirement of 37 C.F.R. § 1.98(a)(3)(i).³ Accordingly, Applicant is re-submitting, in a separate, new supplemental IDS, the Japanese-language references along with an English translation of the ISR. Applicant respectfully requests that the references be considered once the Examiner receives the newly filed IDS.

The second reference listed in the IDS filed on September 27, 2006, with the Cite No. “BB,” was given as “JP 02/081448 A1.” Applicant clarifies for the record that this was a typographical error and should have been “WO 2002/081448 A1” instead. The correction will be made in the supplemental IDS to be filed.

VII. Objection to the Specification

The Specification is objected to for failing to include certain sections and in the order provided in 37 C.F.R. § 1.77(b).

Applicant has amended the Specification to comply with 37 C.F.R. § 1.77(b). Accordingly, Applicant respectfully requests that the objection to the Specification be withdrawn.

VIII. Claim Rejections under 35 U.S.C. § 112, ¶ 1

Claims 1-13 are rejected under 35 U.S.C. § 112, ¶ 1, for lack of enablement. The Examiner states that the Specification does not reasonably provide enablement for the scope of compounds encompassed by the portions of the variables (R^1 , A, R^{10} , G^1 , and R^2) that recite “a five or six membered heterocyclic group” and by the phosphorus-containing substituents recited for R^1 .

³ MPEP § 609.04(a).III states, in relevant part: “Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an ‘X’, ‘Y’, or ‘A’ indication on a search report.”

Claim 1, as amended, now recites only a selection of exemplified heterocyclic groups for the variables, supported by actual examples disclosed in the Specification. Claim 1 also no longer recites a phosphorus-containing substituent for R¹.

Accordingly, Applicant respectfully submits that claim 1 is enabled, and respectfully requests that the rejection of claim 1 be withdrawn.

Claims 2, 3, and 7 depend, directly or indirectly, from claim 1. Therefore, for the same reason as stated above for claim 1, these claims are enabled. Applicant respectfully requests that the rejections of claims 2, 3, and 7 be withdrawn.

Applicant has canceled claims 4-6 and 8-13, rendering the rejections of these claims moot.

IX. New Claims 14-25

New claims 14-25 have been added. They are method claims that depend directly or indirectly from claim 1. Applicant respectfully submits that claims 14-25 are allowable.

CONCLUSION

In view of the foregoing, it is believed that claims 1-3, 7, and 14-25 are in immediate condition for allowance and it is respectfully requested that the application be reconsidered and that all pending claims be allowed and the case passed to issue.

If there are any other issues remaining which the Examiner believes could be resolved through a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

Dated: June 23, 2008

Respectfully submitted,

By 

Louis J. DelJudice

Registration No.: Reg. No. 47,522

DARBY & DARBY P.C.

P.O. Box 770

New York, New York 10008-0770

(212) 527-7700

(212) 527-7701 (Fax)

Attorneys/Agents For Applicant